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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/972,374	11/24/97	BAKKER W	GLP006/JTN

IM71/0412

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EXAMINER	
WATKINS III,W	
ART UNIT	**PAPER NUMBER**
1772	

DATE MAILED: 04/12/99

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.	Applicant(s)	
08/977,374	Bakker	
Examiner	Group Art Unit	
W. Watkins	1772	

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

P riod for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication .
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

☑ Responsive to communication(s) filed on March 1, 1999.

☑ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 1 1; 453 O.G. 213.

Disp sition of Claims

☑ Claim(s) 1-9, 21-23, 26, 36-46 is/are pending in the application.

Of the above claim(s) 1-9, 21-23, 26 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☑ Claim(s) 36-46 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Pri rity under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 11 9(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 1 7.2(a)).

*Certified copies not received: _____.

Attachment(s)

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of References Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Other _____

Office Acti n Summary

DETAILED ACTION

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 36-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heilman et al. (Australia 27,337) in view of Konger (U.S. 3,760,154) further in view of Anderson et al. (U.S. 5,113,479).

Heilman et al. teach a film which extends over the rim of a container and is heat shrunk onto the container by applying energy which may be in the form of infrared radiation to the edge first while the top is shielded, then to the top as an option to further tighten the film (page 10). The film may be transparent (page 3). Konger teaches the use of infrared radiant heat directly on the overhanging edge of a transparent shrink wrap film in order to form a cover over an object to be packaged, the direct radiation on the edge is intense (abstract, col. 2, lines

35-45, col. 6, lines 60-69, col. 10, lines 15-25). Anderson et al. teach the use of coloring on a edge to better absorb infrared radiation to raise the temperature to heat seal the edge of the film (abstract). The instant invention claims a printed area on the edge rim of a film lid to better absorb radiation in order to heat shrink the film. It would have been obvious to one of ordinary skill in the art to direct the infrared radiation of Heilman et al. directly on the edge of Heilman et al. in order to better shrink the transparent edge of Heilman et al. because of the teachings of Konger to use intense direct radiation on overhanging edges to be shrunk. It further would have been obvious to color the edge of the film of Heilman et al. in view of Konger in order to use less intense infrared energy but still cause shrinking in order to save energy because of the teachings of Anderson et al. that use of opaque areas increase absorbance of infrared radiation. Use of film in a roll to make lids and printing and use of tint to create opaque areas for infrared absorption are conventional.

3. The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA

1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) and© may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 36-46 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 15, 16 and 19 of copending Application No. 08/699,332. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims differ only in the language used to describe the same structure.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Applicant's arguments filed March 1, 1999 have been fully considered but they are not persuasive.

Applicant argues that both Heilman et al. and Konger teach the use of ovens, where infrared rays are first converted to diffuse heat, which is then used to heat the edges, as well as the other portions of a shrink lid, unless those portions, such as a top, are shielded by insulation. While the examiner admits, that Heilman et al. may not explicitly teach the direct exposure of the edges of the film lid to infrared radiation, Konger explicitly teaches that infrared radiation is directed onto the bottom of the bag first, and that the bottom of the bag is heated both by direct contact of the rays, and from rays which pass through the film and heat the material under the film, which material absorbs the rays and produces heat, which is transmitted to the bottom hanging edges (abstract, col. 2, lines 35-45, col. 6, lines 60-69, col. 10, lines 15-25). Thus there is a clear teaching of infrared rays directed at the edges of a film lid. This provides an alternate way of heating only the edges of Heilman et al. without the use of an insulation layer on the top of the lid film.

Given that Heilman et al. in view of Konger establishes a motivation for directing infrared radiation onto the edge of a film lid for the purpose of heating, the examiner is of the position that Anderson is analogous art that addresses the common problem of heating selected areas of thermoplastic films or webs

with IR radiation, said films and webs being used to form packages or closures on containers. Applicant argues that Anderson has the direct opposite problem of applicant in that Anderson is directed to focusing radiation on a particular spot, to prevent absorption by other areas of the web that may by opaque, while applicant is trying to get a particular area to increase the amount of radiation absorbed, in a film that does not otherwise absorb IR radiation. The position of the examiner is that Anderson provides motivation to use an absorbent coating on a specific location to increase the amount of heat absorbed for a given amount of radiation exposure and that this teaching would be transferred to the combination of Heilman in view of Konger by one of ordinary skill in the art regardless of the fact that other non-selected areas of Heilman in view of Konger are transparent and that other non-selected areas of Anderson may be opaque. What matters is the common problem of heating, in an efficient manner, the selected area of each reference.

Applicant also argues that Heilman et al. has a complete solution to the problem of selected heating by use of a insulated top cover and that therefore there is no motivation to substitute another way of selectively heating the edges of the film lid. One of ordinary skill in the art is not limited to the solution of a problem taught in a particular reference but may substitute

similar ways to solve a common problem that have advantages not foreseen by the inventor of the first reference. In the above combination, the teachings of Konger and Anderson et al. allow for the simplification of the apparatus of Heilman et al. by possible elimination of the top insulated cover.

Regarding the 132 declaration filed in the 08/699,332 case, the examiner only takes the showing, at best, to be an indication of future possible commercial success. There is no evidence of the amount of sales of lids of the instant invention relative to lids in general or even lids in the fast food take out business. Such evidence may develop over time, if applicant's lids are adopted by a major fast food chain, but cannot be said to be of record at this time. A second problem is nexus. Applicant is testing a system that includes a machine for lid application, a method of applying the lids and the lids themselves. There is no evidence that some other element, such as the machine for lid application, is not the reason for the commercial success that applicant alleges.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William P. Watkins III whose telephone number is (703) 308-2420.

The examiner's normal work hours are Monday through Friday 9:30 A.M. through 6:00 P.M. The examiner's supervisor is Ellis Robinson whose telephone number is (703) 308-2364. Any general inquiry can be directed to the Group receptionist whose telephone number is (703) 308-0651.

The Fax number for official **after final** papers is 703-305-3599. The Fax number for official **non-final** papers is 703-305-5408. The Fax number for **informal** non-official communications directed to the examiner is 703-305-5436.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [**ellis.robinson@uspto.gov**].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

William P. Watkins III

WILLIAM P. WATKINS III
PRIMARY EXAMINER

WW/ww
April 11, 1999